REMARKS

This is intended as a full and complete response to the Final Office Action dated June 22, 2005, having a shortened statutory period for response set to expire on September 22, 2005. Applicant submits this response to place the application in condition for allowance or in better form for appeal. Please reconsider the claims pending in the application for reasons discussed below.

Claims 1-31 and 33-36 are pending in the application. Claims 1-31 and 33-36 remain pending following entry of this response.

Claim Rejections - 35 U.S.C. § 103

Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Keeney et al.* (US. patent 6,748,471, hereinafter *Keeney*) in view of *Irons* (US patent 6,192,165) and further in view of *Costello* (US. patent 5,547,178).

The Examiner takes the position that *Keeney* discloses "A method for affixing labels on a printed output medium for separating print jobs comprising: spooling at least one print file to a print queue." *Keeney* col. 7:50-60. Furthermore, the Office Action states that *Irons* discloses "executing a print label program for identifying a first page of each print job in the print queue." *Irons* col. 8:1-8. Finally, the Office Action contends that *Costello* discloses "generating an identification label for each print job; wherein each identification label includes information specific to the respective print job in order to distinguish separate print jobs; and automatically affixing a label on the first page of each print job without user intervention." *Costello* col. 13:36-46.

Applicant respectfully traverses this rejection.

The Examiner bears the initial burden of establishing a *prima facie* case of obviousness. *See* MPEP § 2142. To establish a *prima facie* case of obviousness three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *See* MPEP § 2143. The present rejection fails to establish at least the third criteria.

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First, Applicant notes that the Office Action incorrectly states that *Keeney* discloses, "a method for affixing labels on a printed output medium for separating print jobs", citing *Keeney* col. 7:50-60. In fact, *Keeney* col. 7:50-60 teaches each document being assigned a file number.

Assuming the Office Action meant to refer to *Irons* col. 7:50-60, Applicant nevertheless submits the rejection is deficient because *Irons* does not teach "a method for affixing labels on a printed output medium for separating print jobs." Instead, the language cited by the Office Action discloses assigning a document number to a document received by a user as a reference for indexing the document. *Irons* col. 7:50-60. Respectfully, a document received by a user is not equivalent to a print job. In addition, although *Irons* discloses a label printing device that affixes labels on a printed output medium at Fig. 1 202, this procedure is done for indexing a document received by the user, not to separate print jobs. *Irons* col. 7:50-60. Therefore *Irons* fails to teach or suggest "a method for affixing labels on a printed output medium for separating print jobs."

Irons also fails to disclose "executing a print label program for identifying a first page of each print job in the print queue." The indexing method disclosed by *Irons* does not involve print jobs in a print queue. Further, *Irons* does not disclose executing a print label program that identifies the first page of a label. Instead, *Irons* teaches placing labels on the first pages of an incoming (already printed) document. *Irons* col. 7:65-66. Respectfully, placing printed labels on the first page of an incoming document is not equivalent to identifying a first page of a print job in a print queue. Therefore, *Irons* fails to teach or suggest the element of "identifying a first page of each print job in the print queue" in Claim 1.

Furthermore, with regards to *Costello*, the Office Action references *Costello* col. 13:36-38, which discloses, "generat[ing] (prints in the printer) a banner sheet whenever a mailbox unit requires splitting a job (or the placement of a portion of a job for any other reason) in a location other than where it was expected . . . ." *Costello*, col. 13 lines 36-39. Respectfully, a banner sheet is not equivalent to a label. A banner sheet is a separate printed page, and is not a label *affixed* to the *first page* of a print job. *Costello* col. 8:31-32. The Examiner is directed to the Applicant's background for a discussion of

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banner pages. Furthermore, the method disclosed in *Costello* only prints a banner sheet when splitting a job or placing a part of a job in an unexpected location, but does not *affix* a *label* to *each* print job. *Costello* col. 13:36-41. Therefore, *Costello* fails to teach or suggest the element of "generating an identification label for each print job . . . and automatically affixing a label on the first page of each print job" in Claim 1.

The Office Action fails to establish a *prima facie* case of obviousness, because its basis for rejecting the claims under § 103 fails to teach or suggest all the claim limitations. Therefore, the claims are believed to be allowable, and allowance of these claims is respectfully requested.

With regards to Claim 11, the Office Action does not provide any grounds for rejecting the claim. Assuming the Office Action meant to rely on the arguments for Claim 1 to reject Claim 11, Claim 11 and all claims that depend from Claim 11 are believed to be allowable for the same reasons given above for Claim 1, and allowance of these claims is respectfully requested.

Claims 22-26 are rejected under 35 U.S.C. 103(a) as being obvious over *Irons* (U.S. patent 6,192,165) in view of *Costello* (U.S. patent 5,547,178).

The Office Action takes the position that *Irons* discloses "A system for affixing labels on printed output medium for separating print jobs comprising: at least one computer device; a printing device coupled to the at least one computer device for printing documents according to print jobs; a label affixing device coupled to the printing device." *Irons* col. 7:50-67. Furthermore, the Office Action asserts that *Costello* discloses the element of "for printing documents according to print jobs and automatically affixing labels on the printed document and a controller for controlling the label affixing device to affix a separate label to each separate printed document corresponding to a different print job so that the separate printed document can be visually distinguished from one another by their respective labels." *Costello* col. 8:16-32; col. 13:36-38, 41-44.

Applicant respectfully traverses this rejection.

The present rejection fails to teach or suggest all the claim limitations of claims 22-26. *Irons* does not teach separating print jobs. *Irons* assigns a file number to a document received by a user as a reference for indexing a document. *Irons* col. 7:50.

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Respectfully, assigning a file number to a document received by a user for indexing purposes is not equivalent to "affixing labels on a printed output medium for separating print jobs". *Irons* does not disclose a printer other than a labeling device. *Irons* Fig. 1, col. 6:55-60. Even if, purely for the sake of argument, one construed the labels disclosed in *Irons* col. 7:50-60 as print jobs, *Irons* does not disclose a system that affixes labels on a printed output medium for separating the labels. To satisfy such a reading would require *Irons* to have labels that separate the labels. Therefore, *Irons* fails to teach or suggest the element of separating print jobs.

With regards to *Costello*, a banner page is a separate printed page, and is not equivalent to a label *affixed* to *each separate* printed document. *Costello* col. 8:31-32. The method disclosed in *Costello* only prints a banner sheet when splitting a job or placing a part of a job in an unexpected location, but does not *affix* a separate label to *each* separate printed document. *Costello* col. 13:36-41. *Costello* fails to teach affixing a separate label to each separate printed document.

Accordingly, the Office Action fails to establish a *prima facie* case of obviousness, because the references cited by the Office Action fail to teach or suggest all the claim limitations of the rejected claims. Therefore, claim 22-26 are believed to be allowable, and allowance of these claims is respectfully requested.

Allowable Subject Matter

Claims 27-31 and 33-36 are allowed. Applicant acknowledges the allowable subject matter, but because the base claims are believed to be in condition for allowance, Applicant elects not to re-write claims 27-31 and 33-36 at this time.
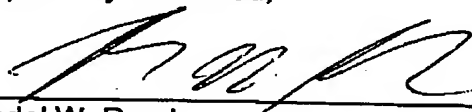
Conclusion

Having addressed all issues set out in the office action, Applicant respectfully submits that the claims are in condition for allowance and respectfully requests that the claims be allowed.

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If the Examiner believes any issues remain that prevent this application from going to issue, the Examiner is strongly encouraged to contact the undersigned attorney to discuss strategies for moving prosecution forward toward allowance.

Respectfully submitted,

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